



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,973	09/18/2003	Quang Tran	016355-004600US	5340
8791 7590 11/29/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER ALI, SHUMAYA B	
			ART UNIT 3771	PAPER NUMBER
			MAIL DATE 11/29/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/665,973	TRAN ET AL.	
	Examiner	Art Unit	
	Shumaya B. Ali	3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 28-35 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-35 and 37-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/18/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

In response to the office action mailed on 10/3/07, Applicant has cancelled claims 1-27,36, and 45-54. Currently claims 28-35, and 37-44 are pending in the instant application.

### *Allowable Subject Matter*

The indicated allowability of claims 28-35, and 37-44 is withdrawn in view of the newly discovered reference(s) to Lowe et al. US 6,709,667 B1. Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 28-35, and 37-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Lowe et al. US 6,709,667 B1.**

The applied reference has a common **assignee** with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to **claim 28, Lowe** discloses a system for delivering a contraceptive device within a fallopian tube, the system comprising: a catheter (**fig. 1, 20,16**) comprising: an elongate tubular catheter body (**see fig.1**) having a proximal (**toward 30 in fig.1**) portion adjacent a proximal end (**fig.1, 32**), a distal portion (**fig.1 depicts the distal end of the catheter**) adjacent a distal end, and at least one lumen (**fig.1 depicts that structure 18 is contained within a lumen**); at least one coil (**fig.3, 56**) disposed along the catheter body nearer the distal end than the proximal end and encircling the lumen (**see fig.3**); wherein the distal portion inherently has varying degrees of flexibility determined by constraining the coil and is adapted to couple to a contraceptive device (and a contraceptive device (**fig.1,12**) releasably disposed at least partially within the lumen of the catheter near the distal portion (**see release catheter 16 in col.8, line 15**); and a deployment member (**fig.1, 18**) in detachable (**18 is threaded, see col.8, lines43 and 44, thus can be detachable**) engagement with the contraceptive device for deploying the contraceptive device from the catheter.

As to **claim 29, Lowe** discloses a system as in claim 28, wherein the distal portion of the catheter body is more flexible towards the distal end of the catheter body than towards the proximal end (**the distal portion is inherently more flexible due to the coil composition, see col.10, liens 54-68**).

As to **claim 30, Lowe** discloses a system as in claim 29, wherein the distal portion of the catheter body comprises multiple layers (**figs. 1 and 3, reference objects 14, 50, and 56**), and the at least one coil comprises one of the layers (**see fig.3**).

As to **claim 31, Lowe** discloses a system as in claim 30, wherein the multiple layers comprise: an inner layer (**see fig.3, 50**); a middle layer (**fig.3, 56**); and an outer layer (**fig.1, 14**).

As to claim 32, Lowe discloses a system as in claim 31, wherein the middle layer comprises the coil (see fig.3).

As to claim 33, Lowe discloses a system as in claim 32, wherein the coil comprises at least one material selected from the group consisting of nickel-titanium alloy, stainless steel, titanium and a polymer (in col.18, lines 68 Lowe discloses the coil can be stainless steel).

As to claim 34, Lowe discloses a system as in claim 31, wherein the inner layer comprises at least one material selected from the group consisting of polytetrafluoroethylene, etched polytetrafluoroethylene and a fluoropolymer (col.18, lines 57-68, and col.19, lines 1-16).

As to claim 35, Lowe discloses a system as in claim 31, wherein the outer layer comprises at least one polyurethane material(col.18, lines 57-68, and col.19, lines 1-16).

As to claim 37, Lowe discloses a system as in claim 29, wherein the distal portion comprises: a first segment (fig.1B, 30); and at least a second segment (fig.1. 20) distal to the first segment, wherein the second segment is more flexible than the first segment (the second segment deflects in to the uterus while the first segment stays outside of the uterus, thus the deflection nature makes the second segment more flexible than the first segment, see figs.11B).

As to claim 38, Lowe discloses a system as in claim 37, further comprising a third segment (fig.1, 24) distal to the second segment, wherein the third segment is more flexible than the second segment

As to claim 39, Lowe discloses a system as in claim 38, wherein the distal portion comprises: an inner layer (fig.3, 50); a middle layer (fig.3, 56); and an outer layer (fig.1, 14).

**As to claim 40, Lowe** discloses a system as in claim 39, wherein the middle layer comprises the coil (see fig.3) and the outer layer comprises at least one polyurethane material (col.18, lines 57-68, and col.19, lines 1-16).

**As to claim 41, Lowe** discloses a system as in claim 40, wherein the at least one polyurethane material comprises at least two polyurethane materials for conferring varying levels of flexibility to the distal portion(col.18, lines 57-68, and col.19, lines 1-16).

**As to claim 42, Lowe** discloses a system as in claim 40, wherein the at least one polyurethane material has an increasing amount of flexibility from a proximal end of the distal portion to the distal end of the distal portion(col.18, lines 57-68, and col.19, lines 1-16).

**As to claim 43, Lowe discloses** a system as in claim 28, wherein the proximal portion of the catheter body includes at least one visualization marker near the distal portion for enhancing visualization of a proximal-most end of the distal portion (col.7, lines 12-19).

**As to claim 44, Lowe discloses** a system as in claim 43, wherein the visualization marker comprises at least one radiopaque material (col.7, lines 12-19).

#### ***Response to Arguments***

Applicant's arguments with respect to claims 28-35, and 37-44 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-W-F 8:30am-5:00 pm.

Application/Control Number:

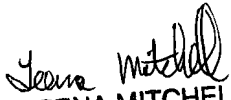
10/665,973

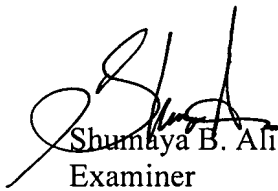
Art Unit: 3771

Page 6

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
TEENA MITCHELL  
PRIMARY EXAMINER

 11/26/07  
Shumaya B. Ali  
Examiner  
Art Unit 3771